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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,062	06/22/2006	Tetsuyuki Nakayasu	2006_0976A	8967
52349 7590 08/19/2010 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER BENGZON, GREG C				
ART UNIT 2444		PAPER NUMBER		
NOTIFICATION DATE 08/19/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/584,062

Applicant(s)

NAKAYASU, TETSUYUKI

Examiner

GREG BENZON

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This application has been examined. Claims 1-15 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/19/2010 has been entered.

Response to Arguments

Applicant's arguments filed 05/06/2009 have been fully considered but they are not persuasive.

The Applicant presents the following argument(s) *[in italics]*:

... McLaren discloses user controlled playback speed of a video stream.
Therefore, the playback speed of the video stream is determined not by data type...
[The prior art does not disclose wherein] playback control is controlled by data type determined by the cited data detecting section...

The Examiner respectfully disagrees with the Applicant.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *controlling reproduction based on data types while excluding user input*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

McLaren disclosed different reproduction methods for different portions of data.

McLaren is not relied upon to disclose wherein *a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data*.

McLaren is not relied upon to disclose *detecting data that is cited from mail data created by a creator different from a creator of the received mail*.

Gupta disclosed (re. Claim 1) detecting data that is cited from mail data (Gupta- Paragraph 63, 'multimedia presentations') created by a creator different from a creator of the received mail. (Gupta- Paragraph 7, 'another student can respond in a subsequent annotation')

The Examiner notes that the basis of the annotations are multimedia presentations which are created independently of the Gupta system. Thus where the claimed *cited data* is the original multimedia presentation disclosed by Gupta, then it would have been obvious that the multimedia presentation could be created by any user. Furthermore Gupta Figure 22, Paragraph 146 displays both the original multimedia presentation (*'cited data created by a different user'*) along with the subsequently added annotations (*'by the creator of the received mail'*) Gupta thus disclose a method for detecting, identifying and differentiating between data that is cited from mail data (Gupta-Paragraph 63, 'multimedia presentations') _created by a creator different from a creator of the received mail_.

Furthermore Gupta Paragraph 135 disclosed a seek option for viewing annotations that allow a user to indicate seek, view an annotation and jump/skip to the next annotation.

The Examiner notes that where the annotations are all imbedded on a single multimedia presentation, then Gupta is able to automatically detect, identify and differentiate between 1) portions of multimedia data that is temporally located between the annotations and 2) portions of multimedia data that have the annotations. The said differentiated portions of multimedia data are equivalent to two different data types. Gupta is thus able to detect two different data types.

The Gupta disclosure regarding jumping/skipping to the next annotation is equivalent to a different reproduction method because it represents a reproduction

method that is temporally faster than the normal viewing mode. Furthermore the said variable reproduction method is performed without involving the user for continually jumping/skipping to the next annotation and without involving the user for detecting the cited data portions.

Thus Gupta disclosed (re. Claim 1) *playback control is controlled by data type determined by the cited data detecting section*. Gupta disclosed (re. Claim 1) *controlling a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data based on the detection result by the cited data detecting section*.

McLaren has overlapping disclosures regarding different reproduction methods for different portions of data but is on a more granular level because McLaren allows for variable speeds.

With McLaren disclosing different reproduction speeds for different portions of data, the combination of McLaren-Gupta disclosed wherein *a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data*.

Priority

This application claims benefits of priority from Foreign Application 2003-429445 filed December 25, 2003.

The effective date of the claims described in this application is December 25, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (US Publication 2005/0081159) further in view of McLaren (US Patent 6064794).

Gupta disclosed (re. Claim 1) an electronic mail processing apparatus comprising: a data receiving section operable to receive mail data including video data or audio data; (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79) a cited data detecting section operable to detect a cited part of the received video data or audio data as cited data from the mail data received by the data receiving section; (Gupta-Paragraph 96-Paragraph 98) and a reproduction control section operable to

control a reproducing method of the received mail data. (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

Gupta disclosed (re. Claim 1) detecting data that is cited from mail data (Gupta-Paragraph 63, 'multimedia presentations') created by a creator different from a creator of the received mail. (Gupta- Paragraph 7, 'another student can respond in a subsequent annotation')

The Examiner notes that the basis of the annotations are multimedia presentations which are created independently of the Gupta system. Thus where the claimed *cited data* is the original multimedia presentation disclosed by Gupta, then it would have been obvious that the multimedia presentation could be created by any user. Furthermore Gupta Figure 22, Paragraph 146 displays both the original multimedia presentation ('*cited data created by a different user*') along with the added annotations ('*by the creator of the received mail*').

Furthermore Gupta Paragraph 135 disclosed a seek option for viewing annotations that allow a user to indicate seek, view an annotation and jump/skip to the next annotation.

The Examiner notes that where the annotations are all imbedded on a single multimedia presentation, then Gupta is automatically able to detect, identify and differentiate between 1) portions of multimedia data that is temporally located between the annotations and 2) portions of multimedia data that have the annotations. The said differentiated portions of multimedia data are equivalent to two different data types. Gupta is thus able to detect two different data types without user input.

The Gupta disclosure regarding jumping/skipping to the next annotation is equivalent to a different reproduction method because it represents a reproduction method that is temporally faster than the normal viewing mode and said reproduction method is performed without involving the user for continually jumping/skipping to the next annotation.

Thus Gupta disclosed (re. Claim 1) *playback control is controlled by data type determined by the cited data detecting section*. Gupta disclosed (re. Claim 1) *controlling a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data based on the detection result by the cited data detecting section*.

McLaren has overlapping disclosures regarding different reproduction methods for different portions of data but is on a more granular level because McLaren allows for variable speeds.

With McLaren disclosing different reproduction speeds for different portions of data, the combination of McLaren-Gupta disclosed wherein *a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data*.

While Gupta substantially disclosed the claimed invention Gupta did not disclose (re. Claim 1) wherein the reproduction control section controls the reproduction method

so that a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data.

McLaren disclosed (re. Claim 1) wherein the reproduction control section controls the reproduction method so that a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data. (McLaren-Column 5 Lines 40-65)

Gupta and McLaren are analogous art because they present concepts and practices regarding the playback control of video segments. At the time of the invention it would have been obvious to combine McLaren into Gupta. The motivation for said combination would have been to facilitate various trick-play modes by controlled selection of "replay" locations. (McLaren-Column 2 Lines 20-35)

Claim 8 (re. method) is rejected on the same basis as Claim 1.

The motivation to combine described in Claim 1 applies to Claim 8.

Gupta-McLaren disclosed (re. Claim 2,9) wherein the reproduction control section controls the reproduction speed of the mail data so as to reproduce the data other than the cited data in the received mail data at a first speed, and reproduce the cited data at a second speed which is faster than the first speed. (McLaren-Column 5 Lines 40-65)

The motivation to combine described in Claim 1 applies to Claims 2,9.

Gupta-McLaren disclosed (re. Claim 3,10) wherein the cited data includes information relating to a creator of the mail data in a specified region, (Gupta-

Paragraph 52, Paragraph 61-63) and the cited data detecting section detects the cited portion by using the information relating to the creator. (Gupta-Paragraph 52, Paragraph 61-63)

The motivation to combine described in Claim 1 applies to Claims 3,10.

Gupta-McLaren disclosed (re. Claim 4,11) wherein the video data or audio data included in the cited data is data compressed by a specified compressing method (McLaren-Column 5 Lines 40-65, Column 6 Lines 60-65) and having a header portion in which information relating to a creator of the mail data is recorded. (Gupta-Paragraph 52, Paragraph 61-63)

The motivation to combine described in Claim 1 applies to Claims 4,11.

Gupta-McLaren disclosed (re. Claim 5,12) wherein the cited data includes information relating to a creator of the mail data in a form of a digital watermark embedded in the video data or audio data, and the cited data detecting section detects the cited data by using the information relating to the creator embedded in a form of a digital watermark.

The Examiner notes that at the time of the invention the use of digital watermarks with email and multimedia content was well-known in the networking art. It would have been obvious to use digital watermarks in the Gupta-McLaren in order to provide a unique identifier for said content and content creator.

The motivation to combine described in Claim 1 applies to Claims 5,12.

Gupta-McLaren disclosed (re. Claim 6,13) comprising a data creating section operable to create the mail data for transmission including video data or audio data,

wherein when creating the mail data, the data creating section stores information relating to a creator of the mail data in a specified recording region of the video data or audio data. (McLaren-Paragraph 61-Paragraph 63)

The motivation to combine described in Claim 1 applies to Claims 6,13.

Gupta-McLaren disclosed (re. Claim 7,14) a data creating section operable to create the mail data for transmission including video data or audio data, wherein when creating the mail data, the data creating section embeds information relating to a creator of the mail data in a form of a digital watermark in the video data or audio data.

The Examiner notes that at the time of the invention the use of digital watermarks with email and multimedia content was well-known in the networking art. It would have been obvious to use digital watermarks in the Gupta-McLaren in order to provide a unique identifier for said content and content creator.

The motivation to combine described in Claim 1 applies to Claims 7,14.

Gupta-McLaren disclosed (re. Claim 15) an electronic mail processing system comprising a first mail processing apparatus and a second mail processing apparatus which exchanges electronic mails with the first mail processing apparatus, a) the first mail processing apparatus including: a data transmitting and receiving section operable to transmit and receive mail data including video data or audio data, (Gupta-Paragraph 92,Paragraph 163,Paragraph 77-Paragraph 79) a cited data detecting section operable to detect a cited part of video data or audio data as cited data from the received mail data, (Gupta-Paragraph 96-Paragraph 98) a reproduction control section operable to

control a reproducing method of the received mail data (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

so that a reproduction method for the cited data is deferent from a reproduction method for data other than the cited data in the received mail data, (McLaren-Column 5 Lines 40-65)

and a data creating section operable to create mail data for transmission by adding information relating to a creator of the mail data to video data or audio data included in the mail data, (Gupta-Paragraph 52, Paragraph 61-63) and b) the second mail processing apparatus including: a data transmitting and receiving section operable to transmit and receive mail data, (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

and a data editing section operable to edit the mail data received in the data transmitting and receiving section, (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

wherein the second mail processing apparatus creates a reply mail (Gupta-Figure 19, Paragraph 127) including as cited data a part or whole of video data and audio data included in the received mail data, by the data editing section, and transmits a reply mail to a sender of the received mail data through the data transmitting and receiving section. (Gupta-Figure 19, Paragraph 127)

The Examiner notes that the basis of the annotations are multimedia presentations which are created independently of the Gupta system. Thus where the claimed *cited data* is the original multimedia presentation disclosed by Gupta, then it

would have been obvious that the multimedia presentation could be created by any user. Furthermore Gupta Figure 22, Paragraph 146 displays both the original multimedia presentation (*'cited data created by a different user'*) along with the added annotations (*'by the creator of the received mail'*).

Furthermore Gupta Paragraph 135 disclosed a seek option for viewing annotations that allow a user to indicate seek, view an annotation and jump/skip to the next annotation.

The Examiner notes that where the annotations are all imbedded on a single multimedia presentation, then Gupta is automatically able to detect, identify and differentiate between 1) portions of multimedia data that is temporally located between the annotations and 2) portions of multimedia data that have the annotations. The said differentiated portions of multimedia data are equivalent to two different data types. Gupta is thus able to detect two different data types without user input.

The Gupta disclosure regarding jumping/skipping to the next annotation is equivalent to a different reproduction method because it represents a reproduction method that is temporally faster than the normal viewing mode and said reproduction method is performed without involving the user for continually jumping/skipping to the next annotation.

Thus Gupta disclosed (re. Claim 1) *playback control is controlled by data type determined by the cited data detecting section*. Gupta disclosed (re. Claim 15) *controlling a reproduction method for the cited data is different from a reproduction*

method for data other than the cited data in the received mail data based on the detection result by the cited data detecting section.

McLaren has overlapping disclosures regarding different reproduction methods for different portions of data but is on a more granular level because McLaren allows for variable speeds.

With McLaren disclosing different reproduction speeds for different portions of data, the combination of McLaren-Gupta disclosed wherein *a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data.*

While Gupta substantially disclosed the claimed invention Gupta did not disclose (re. Claim 15) wherein the reproduction control section controls the reproduction method so that a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data.

McLaren disclosed (re. Claim 15) wherein the reproduction control section controls the reproduction method so that a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data. (McLaren-Column 5 Lines 40-65)

Gupta and McLaren are analogous art because they present concepts and practices regarding the playback control of video segments. At the time of the invention it would have been obvious to combine McLaren into Gupta. The motivation for said

combination would have been to facilitate various trick-play modes by controlled selection of "replay" locations. (McLaren-Column 2 Lines 20-35)

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREG BENGZON whose telephone number is

(571)272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Bengzon/
Examiner, Art Unit 2444